

## REMARKS

Applicants respectfully request reconsideration of the present application based on the following remarks. Claims 1 and 16 are amended herewith. Claims 1-2, 4-6, 9, 11-13, 16-17, 19-21, 24, 26-28, and 31-41 are pending in the application.

### *Claim Rejections Under 35 U.S.C. 103 in view of Rosenthal, Chiniwala and Mills*

Claims 1-2, 4, 6, 9, 11, 13, 16-17, 19, 21, 24, 26 and 28 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,737,701 to Rosenthal et al. ("Rosenthal") in view of U.S. Patent No. 6,175,622 to Chiniwala et al. ("Chiniwala") and further in view of U.S. Patent No. 6,665,529 to Mills Jr. ("Mills"). For reasons set forth more fully below, Applicants respectfully traverse this rejection.

Applicants incorporate and restate prior arguments made in response to rejections made in previous Office Actions. Independent claim 1 explicitly requires (with similar limitations in each of the other independent claims 9, 16, and 24):

A method for providing access to resources with the use of personal identification numbers, comprising the steps of:

**concurrently maintaining** a system-wide list of resources associated with a plurality of subscribers regardless of subscriber identity **and a separate and distinct** plurality of lists of resources respectively associated with subscribers;

receiving a request from a subscriber to access a resource;

**[1] first comparing the resource to the system-wide list;**

if the resource is included in the system-wide list:

providing or denying access to the resource in accordance with the system-wide list;

**if the resource is not included in the system-wide list:**

**retrieving one of the plurality of lists associated with the subscriber;**

**[2] next comparing the resource to the retrieved list associated with the subscriber;**

Thus, independent Claims 1, 9, 16, and 24 clearly require:

- Comparing a requested resource against both a system-wide list associated with a plurality of subscribers and a list associated with the subscriber that is separate from the system-wide list,

- A progression of first comparing the requested resource to a system-wide list associated with a plurality of subscribers and next comparing the requested resource to a list associated with the subscriber that is separate from the system-wide list if the resource is not in the system-wide list,
- Controlling access to a requested resource depending on its presence on a system-wide list associated with a plurality of subscribers then determining whether to require authentication for a requested resource depending on a subscriber-specific list.<sup>1</sup>

Neither Chiniwala, Rosenthal nor Mills Teach Checking A Requested Resource Against Both A System-Wide List Associated With A Plurality Of Subscribers Regardless Of Subscriber Identity And A Separate List Associated With A Particular Subscriber.

The independent claims all require comparing a requested resource against **both** a system-wide list associated with a plurality of subscribers regardless of subscriber identity **and** a **distinct** and **separate** list that is associated with a particular subscriber. The Office Action relies on Chiniwala for meeting the limitation of a system wide-list, and Rosenthal for meeting the limitation of a list associated with a particular subscriber. The Office Action further states that Mills “teaches checking more than one list.”

As Applicants have already demonstrated, neither Chiniwala nor Rosenthal teaches the concurrent maintenance of, or comparing requested resources to, **distinct and separate** lists within the same system. Instead, Chiniwala and Rosenthal merely suggest the maintenance of only one of the types of lists at the exclusion of the other. The newly alleged combination with Mills does not cure this deficiency.

Specifically, Mills merely teaches what Chiniwala teaches and does not add any substantively different subject matter. Chiniwala teaches the maintenance of a White List and a Black List. The White List consists of numbers which end users can only place calls to, while the Black List consists of numbers which end users cannot place calls to. Both lists “may be common to all users or they may be organized into groups....”(col. 8 lines 40-41.) Thus, at best

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<sup>1</sup> Although it is believed the claims were already clearly distinctive, claims 1 and 16 have been amended herewith to more clearly point out that the concurrently maintained system-wide list

Chiniwala suggests the maintenance of a system-wide list at the exclusion of maintaining a more specific calling list associated with a group.

Similarly, Mills merely teaches the use of a White List, a Black List and a Gray List. “The black list is essentially a list of all phones or handsets that are invalid for some reason, e.g., stolen. The gray list is essentially a list of all phones or handsets having some particular problem, but they are not necessarily listed as a bad or invalid phone. The white list is essentially a list of all phones that are specifically approved for use within the network 10.” (col. 7, lines 25-31). There is no teaching or suggestion that Mills associates any of these lists with a “subscriber identity,” much less comparing a requested resource against any such subscriber-specific list as is required by the independent claims.<sup>2</sup> In short, Mills merely adds a Gray List to Chiniwala’s White and Black Lists.

Accordingly, just like Chiniwala, Mills does not suggest comparing a requested resource against both a list associated with a specific user and a separate and distinct system-wide list. Moreover, it does not matter if “Mills Jr. teaches checking more than one list” (presumably the “White,” “Black” and “Gray” lists) as stated in the Office Action, because the claims require much more than just checking different lists. Specifically, the claims require comparing a requested resource against both a system-wide list associated with a plurality of subscribers and a list associated with the subscriber that is separate from the system-wide list. These specific claim requirements are not suggested by Chiniwala, Mills or Rosenthal.

For at least the foregoing reasons, the cited prior art fails to teach all the limitations of claims 1, 9, 16, and 24.

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and subscriber list are distinct and separate (though they might be implemented together in a common storage medium or tabular structure).

<sup>2</sup> Applicants also note that the cited portions of Mills describe prior art techniques that Mills attempts to improve upon (see FIG. 3). Accordingly, such descriptions would not be enabling of any alleged invention.

Neither Chiniwala, Rosenthal Nor Mills Teaches First Comparing The Requested Resource To A System-Wide List Associated With A Plurality Of Subscribers And Then Next Comparing The Requested Resource To A List Associated With The Subscriber That Is Separate From The System-Wide List If The Resource Is Not In The System-Wide List.

The independent claims all require that after receiving an access request for a resource from a subscriber, the steps of the method are to **first** compare the requested resource to a system wide list associated with a plurality of subscribers and to **next** compare the resource to a list associated with the subscriber **if the requested resource is not in the system-wide list**.<sup>3</sup> Neither Chiniwala, Mills nor Rosenthal teaches such a progression of comparison.

Like Chiniwala, Mills teaches merely separate lists (i.e. Black, White, etc.) that are associated with all users or groups of users. Nothing in Chiniwala or Mills suggests any order in how the multiple lists are consulted, much less **first** comparing the requested resource to such system-wide lists associated with a plurality of subscribers and **next** comparing the requested resource to a list associated with the subscriber that is separate from the system-wide list **if the requested resource is not in the system-wide list**, as required by claims 1, 9, 16, and 24.

Rosenthal is solely directed to the maintenance of lists associated to specific user characteristics. Nothing in Rosenthal suggests that the specific user lists must be compared to requested resources, much less **after an unsuccessful comparison to a system-wide list**, as required by claims 1, 9, 16, and 24.

Neither Chiniwala, Rosenthal Nor Mills Teaches Controlling Access To A Requested Resource If It Is On A System-Wide List, And If It Is Not On The System-Wide List, Determining Whether To Require Authentication For The Requested Resource In Accordance With A Subscriber-Specific List

Not only do the claims require concurrently maintaining separate and distinct system-wide list and subscriber-specific lists, but the claims clearly point out a unique fraud prevention process and system. Specifically, all the independent claims clearly require controlling access to a requested resource in accordance with a system-wide list, if it is on that list, and then if it is not,

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<sup>3</sup> This conditional progression is not a mere sequence of steps. As clearly set forth in the claims, the comparison to the user-specific list is not performed if the resource is found in the system-wide list.

determining whether to request authentication for a requested resource depending on a subscriber-specific list.

More specifically, the first access control process includes “providing or denying access” to the requested resource in accordance with the system-wide list. The next access control process includes requiring a PIN to be entered if the resource is not on the subscriber’s specific list, and also not on the system-wide list.

Rosenthal merely describes a process of determining whether authentication is required for a particular dialed phone call. Chiniwala merely lists phone numbers that either are always allowed or always blocked. Mills merely lists phones that cannot be used, may be used or always can be used.

Meanwhile, independent claims 1, 9, 16 and 24 require a first access control process of “providing or denying access” to the requested resource in accordance with the system-wide list, and then a next access control process includes requiring a PIN to be entered if the resource is not on the subscriber’s specific list, and also not on the system-wide list. The claimed invention thus defines multiple levels of distinctions and improvements over the processes of Rosenthal, Chiniwala and Mills, even if they could be combined together. For these additional reasons, claims 1, 9, 16 and 24 patentably define over the cited prior art.

#### The Alleged Combination Of Rosenthal, Chiniwala and Mills Would Not Suggest the Claimed Invention

The cited prior art does not establish a **prima facie** case of obviousness because all claim limitations are not present, even if the references are combined as alleged in the Office Action. Accordingly, it is not necessary to further address the alleged motivation to combine the references. Nevertheless, Applicants submit that the prior art does not suggest a motivation to combine or modify the references in a manner that could result in the invention. MPEP 2143.03.

As set forth above, neither Chiniwala, Mills nor Rosenthal teach or suggest the **concurrent** maintenance of **both** a system-wide list and a user specific list, or the progression of **first** comparing the requested resource to the system-wide lists, and **next** comparing the requested resource to a user specific list **if the requested resource is not in the system-wide list**, the alleged combination of Chiniwala, Mills and Rosenthal would not suggest all the limitations

of independent claims 1, 9, 16, and 24 even if they could be combined as alleged in the Office Action.

The Office Action states that Mills “teaches checking more than one list.” This does not render the claimed inventions obvious. At best, this would merely suggest that if many lists are available, they can all be checked. However, because there is no teaching or suggestion of **concurrently maintaining both** a system-wide list and a subscriber-specific list as set forth in the claims, it would be sheer speculation to conjecture an order with which they would be consulted together, even if multiple references show them individually. Moreover, the references do not provide a suggestion or motivation for combining the separate access control processes that are conditionally sequenced as defined in the claims. Just because a specific order and conditional sequence would be **possible** does not mean the prior art suggests it. MPEP 2143.01.

Accordingly, Applicants submit independent claims 1, 9, 16, and 24, together with claims 2, 4-6, 11-13, 16-17, 19-21, 24, 26-28, and 31-41 that depend therefrom, patentably define over Chiniwala, Mills and Rosenthal.

No Other Cited Prior Art Cures the Deficiencies of Chiniwala and Rosenthal With Respect to Independent Claims 1, 9, 16, and 24

Claims 5, 12, 20, 27, 33, 36, 39, and 42 stand rejected under 35 U.S.C. 103(a) as being allegedly unpatentable over Rosenthal and Chiniwala in view of U.S. Patent No. 6,330,311 Mijares et al. (“Mijares”). Claims 31, 34, 37, and 40 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Rosenthal and Chiniwala in view of Rowell et al, WO 9704602 (“Rowell”). Claims 32, 35, 38, and 41 stand rejected as being allegedly unpatentable over Rosenthal and Chiniwala in view of Rudokas, US Patent 5420910 (“Rudokas”). These claims depend ultimately from independent claims 1, 9, 16, and 24 and thus are patentable for at least the reasons presented above. The deficiencies noted above are not cured by the alleged combinations with Mijares, Rowell, or Rudokas. Neither Mijares, Rowell, nor Rudokas teach or suggest the **concurrent** maintenance of **both** a system-wide list and a user specific list, or the progression of **first** comparing the requested resource to the system-wide list, and **next**

comparing the requested resource to a user specific list **if the requested resource is not in the system-wide list** as required by claims 1, 9, 16, and 39.

***The Dependent Claims Further Patentably Define Over The Cited Prior Art***

Although patentable by virtue of their dependence on patentable subject matter, many of the dependent claims further define over the cited prior art.

For example, claim 2 depends from patentable claim 1 and further requires a “step of adding the resource to the list associated with the subscriber if the subscriber inputs the correct personal identification number.”

The Office Action merely refers to col. 7 of 10-22 of Rosenthal which teaches:

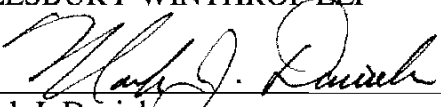
When processor 55 finds a match in automatic authentication database 102 for the MIN/ESN combination of the calling telephone and the destination number dialed by the caller, as determined in step 203, the authentication code entry requirement is waived and the call is then completed in step 209 in the conventional manner without further ado. Thereafter, in step 210, processor 55 may register the time and date, e.g., as derived from its internal clock, of the accessing of the entry associated with the MIN and ESN combination of the calling telephone and the destination number dialed by the caller. Additionally, processor 55 may also increment the counter for that entry.

This merely suggests that a record of a call when a **matching** number is found in the authentication database, and when entering a PIN is **not required**. It does not suggest **adding** a new number to a list, much less after a successful PIN entry is **required and successfully completed**.

For at least these reasons, claims 2 and 17 further patentably define over the cited prior art and the rejections thereof should be withdrawn.

***Conclusion***

All objections and rejections having been addressed, the application is believed to be in condition for allowance and Notice to that effect is earnestly solicited. If any issues remain which the Examiner feels may be resolved through a telephone interview, s/he is kindly requested to contact the undersigned at the telephone number listed below.

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